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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10-019,234 | 04/02 2002 | Othmar Bruhwiler | 041463-5030 | 9880 |

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EXAMINER

WAKS, JOSEPH

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2834

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/019,234 | BRUHWILER, OTHMAR | |
| | Examiner | Art Unit | |
| | Joseph Waks | 2834 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>0403</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The Patent Abstracts of Japan Vol. 008, No. 250 (E-279), 16th November 1984 (1984-11-16) was not considered since it is not listed in IDS and no copy was provided with the application.

2. The information disclosure statement filed on April 2, 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

The non-patent literature document (Leueger et al. "Lexicon der Technik" of 1965) was not considered because it does not include a concise explanation of the relevance.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the several magnets distributed uniformly around the circumference of the stator arranged with matching polarity (NNNN)

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relative to the axis as recited in claim 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. This application does not contain an abstract of the disclosure as required by 37

CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claim 7** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The feature of the several magnets distributed uniformly around the circumference of the stator arranged with matching polarity (NNNN) relative to the axis is not clearly described in the specification and contradicts the drawings (Re Figure 2) showing a north south (NS) arrangement).

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 4 and 11** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 4, the limitation of the two light emitting diodes connected anti-parallel to each other renders the claim indefinite since it is not clear with what respect the connections are anti-parallel.

Re claim 11, the claim is generally narrative and indefinite, failing to conform to current U.S. practice and appears to be a literal translation into English from a foreign document and is replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1 and 2** are rejected under 35 U.S.C. 102(b) as being anticipated by **Burton (US 1,560,535)**.

Burton discloses in Figure 1 invention as claimed: an apparatus having a rotor armature 3, stator magnets 2 and the commutator (or non-luminous signal transmitter) located on the rotor, the apparatus is designed as a windmill provided with blades 9.

11. **Claims 1, 3/1, 5, 6, and 8-10** are rejected under 35 U.S.C. 102(b) as being anticipated by **Price (US 4,298,910)**.

Price discloses invention as claimed: an apparatus having a rotor 11 with coil 26 supported on a stator pin 17, a stator 21 with a permanent magnet 25, and light emitting diodes 14-16 located on the rotor.

12. **Claims 1, and 7-9** are rejected under 35 U.S.C. 102(b) as being anticipated by **Kumakura (US 4,191,988)**.

Kumakura discloses invention as claimed: an apparatus having a rotor 3 with coil 54 mounted on an iron disc 21, 22 (Re column 3, lines 47-49), a stator 18 with permanent magnets 40 distributed uniformly around the circumference of the stator, and light emitting element 11 located on the rotor.

The recitation that the structure includes magnets "preferably arranged with matching polarity (NNNN)" is not a positive limitation and was not given any patentable weight.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 1, 2, and 3/2** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hofmann (DE 27 10 146)** in view of **Price (US 4,298,910)**.

Hofmann discloses a windmill having a rotor 6 with blades 4, a stator (Re page 4, lines 7-11), and light emitting elements 5 located on the rotor. However, **Hofmann** does not disclose the rotor with at least one coil, a stator with at least one magnet, and the light-emitting element being light emitting diodes.

Price discloses an apparatus having a rotor 11 with coil 26 supported on a stator pin 17, a stator 21 with a permanent magnet 25, and light emitting diodes 14-16 located on the rotor for the purpose of providing a rotor with a self containing generator, thus providing a maintenance free power supply to the light emitting elements that eliminates the replacement of batteries, brushes or other similar equipment.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the mill as taught by **Hofmann** and to provide the rotor with at least one coil, a stator with at least one magnet, and the light emitting diodes as taught by **Price** for the purpose of providing a rotor with a self containing generator, thus providing a maintenance free power supply to the light emitting elements that eliminates the replacement of batteries, brushes or other similar equipment. It would have been further obvious to one having ordinary skill in the art at the time the invention was made to provide the light emitting diodes that are well known in the art and require minimum maintenance.

Allowable Subject Matter

15. **Claims 4 and 11** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Re claim 4, the feature of the two diodes being electrically connected in series (or anti-parallel), in combination with the other limitations present, are neither disclosed nor taught by the prior art of record.

Re claim 11, the feature of the light-emitting diodes connected to the coils with the first of the light-emitting diodes receiving the voltage generated in series in at least two of the coils

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and the second light-emitting diodes receiving the voltage generated in series in at least one coil fewer than the first of the light-emitting diode, in combination with the other limitations present, are neither disclosed nor taught by the prior art of record.

Prior Art

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Communication

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Waks whose telephone number is (703) 308-1676. The examiner can normally be reached on Monday through Thursday 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor R Ramirez can be reached on (703) 308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-1341 for regular communications and (703) 305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.


JOSEPH WAKS
PRIMARY PATENT EXAMINER
TC-2800

JW
June 4, 2003

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